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10/826,272	04/19/2004	Kazuhiro Fujii	SN-US045038	9912
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EXAMINER				
LUONG, VINH				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/826,272

**Applicant(s)**

FUJII, KAZUHIRO

**Examiner**

Vinh T. Luong

**Art Unit**

3656

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/17/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 11-18 and 22-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/19/04; 8/2/07; 4/17/08 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Appendices 1 and 2

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 17, 2008 has been entered.
2. The restriction requirement on December 21, 2006 and Applicant's election without traverse of the species of FIGS. 1-16 in the reply filed on January 10, 2007 are carried over to the instant RCE. Please see MPEP § 819.
3. No claim is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 10, 2007.
4. The drawings were received on *August 2, 2007*. These drawings are unacceptable by the Examiner because the amended drawings introduce new matter. See 37 CFR 1.121(f). For example, the plane P added in Fig. 7 introduces new matter. The original disclosure (Spec., ¶ 64) did not disclose the plane P. After the filing date, the specific showing of the plane P within a full spectrum of possible planes disposed on an opposite side from the split S is considered under the present disclosure to be new matter. *Cf., In re Smith*, 173 U.S.P.Q. 679 (CCPA 1972) and *Ex parte George*, 230 U.S.P.Q. 575, 578 (Bd. Pat. App. & Inter. 1986). Put differently, the concept that the operating member 61 is disposed on an opposite side of the plane P perpendicularly to the operating axis X and passes through the center axis C of the transverse portion T of the handlebar 14 as now shown in amended FIG. 7, is not conveyed in the original disclosure, thus,

it introduces new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973). See also 37 CFR 1.81(d) and 35 USC 113.

5. The drawings were received on *April 17, 2008*. These drawings are unaccepted by the Examiner because:

(a) The amended drawings introduce new matter for the same reasons applied to the amended drawings filed on August 2, 2007; and

(b) The replacement drawings are other than black and white drawings as its content is stored in SCORE data base. However, the requirements under 37 CFR 1.84(a)(2) have not been satisfied. See MPEP § 608.02.

6. The *original* drawings are objected to because the drawings are not in compliance with 37 CFR 1.84. See PTO Form-948 mailed on November 15, 2007 and April 18, 2007.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The amendment filed August 2, 2007 is objected to under 35 USC 132(a) because it introduces new matter into the disclosure. 35 USC 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the new description of the plane P in Spec. ¶ 64 quoted below:

[0064] Preferably, a bearing assembly 78 is positioned between the housing 60 and the pivot shaft 72 such that the operating member 61 pivots or rotates smoothly about a rotational operating axis or pivot axis X. Preferably, the pivot axis X of the operating member 61 is non-parallel to a center axis C of the transverse portion T of the handlebar 14. The pivot axis X preferably intersects the curved mounting surface 36d of the tubular clamping portion 36 *such that the operating member 61 is disposed on an opposite side of a plane P from the split S. The plane P is **perpendicular to the operating axis X** and passes through the center axis C of the transverse portion T of the handlebar 14*, as best seen in Figure 7. (Emphasis added).

As noted, the original disclosure did not disclose the plane P. After the filing date, a specific description of the plane P within a full spectrum of possible planes disposed on an opposite side from the split S is considered under the present disclosure to be new matter. *Cf., In re Smith* and *Ex parte George, supra*. Put differently, the concept that the operating member 61 is disposed on an opposite side of the plane P perpendicularly to the operating axis X and passes through the center axis C of the transverse portion T of the handlebar 14 as now shown in amended FIG. 7, is not conveyed in the original disclosure, thus, it introduces new matter. *In re Anderson, supra*.

Applicant is required to cancel the new matter in the reply to this Office Action.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 11-18 and 22-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 11 now recites: “a bicycle computer unit (24) including a display screen (56), *the bicycle computer (24) being supported* by the first tubular clamping member (36) of the first mounting portion (30) *within* the split (S).” (Referential characters and emphasis added).

However, the specification describes and FIGS. 3, 7 and 18 show that the computer unit 24 is located outside of the tubular clamping member 36. In fact, only the computer *support leg* 40 is within the split S. Spec. ¶¶ 53-57. The computer 24 *per se* is not located within the split S as now claimed. See an example of the computer supported within the split in US 6,584,872 issued to Kojima. Thus, Claims 22-31 contains subject matter (i.e., the bicycle computer being supported . . . *within* the split) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention. See MPEP § 2163.01.

Claim 22 as amended on August 2, 2007 recites: “the plane (P) passing through a center axis (C) of the handlebar (14) and being *perpendicular to* the operating axis (X).” (Referential character and emphasis added).

The plane P in the above quotation is unsupported by the original record. In fact, on the filing date, the specification did not describe and the drawings did not show the plane passing through a center axis (C) of the handlebar (14) and being *perpendicular* to the operating axis. The first time that the plane P was introduced into the record was the time of filing of the amended FIG. 7 on August 2, 2007. Therefore, Claims 22-31 contains subject matter (*i.e.*, the plane P perpendicular to the operating axis X) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See MPEP § 2163.01, *supra*.

10. Claims 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 11 recites: “a bicycle computer unit (24) including a display screen (56), *the bicycle computer (24) being supported* by the first tubular clamping member (36) of the first mounting portion (30) *within* the split (S).” (Referential characters and emphasis added).

The above recitation is inconsistent with the specification disclosure. In fact, the specification describes that only the computer *support leg* 40 is within the split S. The computer 24 *per se* is not located within the split S as shown in FIGS. 3, 7, and 18. Spec. ¶¶ 53-57. The above inconsistency renders claim 11 indefinite. See MPEP § 2173.03.

Claim 13/11 is indefinite since claim 13 is inconsistent with claim 11. As noted, claim 11 requires the computer 24 itself being supported *within* the split S. However, claim 13/11 requires the computer support leg 40 *removably secured* within the split S and the computer being

attached to the leg 40. If the leg 40 is removed from the split S, the computer is not supported within the split S as claimed in claim 11.

11. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichida et al. (EP 1 375 325 A2) in view of Kojima (US 6,584,872).

Claim 11

Ichida teaches an electrical bicycle shift control assembly comprising:

a first shift control device 24a (FIG. 2) including a first mounting portion 41 having a first tubular clamping member 41 (see FIG. 3 in Appendix 1 hereinafter “App. 1”) configured to be selectively clamped onto a bicycle handlebar 16 (FIG. 2) and a first electrical shift control switch 40, 42, 44, etc. (Ichida, claims 1-25) attached to the first tubular clamping member 41 of the first mounting portion 41, the first tubular clamping member 41 having a pair of attachment ends (FIG. 9, App. 1) and a band section (FIG. 9) extending between the attachment ends to form a split (at 64a in FIG. 9) between the attachment ends, the tubular clamping member 41 being arranged and configured such that the attachment ends move toward each other (by a bolt 64a and a nut 64b, Ichida, ¶ 39) to reduce an effective inner diameter of a curved mounting surface (FIG. 9, App. 1) of the band section; and

a bicycle computer unit 20 including a display screen 20.

In summary, Ichida teaches the invention substantially as claimed. However, Ichida’s computer 20 is not supported by the first tubular clamping member 41 of the first mounting portion 41 *within* the split. Ichida, FIG. 2.

Kojima teaches the computer 16, 216 supported by the first tubular clamping member 22, 222 of the first mounting portion 12, 212 *within* the split 44 (FIGS. 3 and 5) in order, *e.g.*, to



secure the handlebar 14, 214 and the display/computer 16, 216 in an integrated fashion. Kojima, Summary of the Invention and claims 1-20.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the location of Ichida's computer unit such that it is supported by the first tubular clamping member of the first mounting portion within the split in order, *e.g.*, to secure the handlebar and the display/computer in an integrated fashion as taught or suggested by Kojima. The rearrangement of Ichida's computer as taught or suggested by Kojima would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739. See also rearrangement of parts in MPEP § 2144.04.

#### Claim 12

Ichida teaches second shift control device 24b including a second mounting portion 41 having a second tubular clamping member 41 configured to be selectively clamped onto the bicycle handlebar 16 (FIG. 2) of the bicycle 10 and a second electrical shift control switch 40 mounted to the second mounting portion 41, the bicycle computer unit being *operatively* supported between the first and second shift control devices 24a and 24b by at least the first mounting portion 40. As noted, Ichida's first and second shift control devices are substantially identical to each other. Ichida, ¶¶ 20 and 30.

#### Claim 13

Kojima's first mounting portion 12, 212 includes a computer support leg 62a, 162a, etc. removably secured within the split 44 and having the bicycle computer unit 16, 216 attached to the support leg 62a, 162a, etc. of the first mounting portion 12, 212.

Claim 14

Kojima's computer support leg 62a, 162a, etc. includes a bent section 60a (FIG. 3), 72a (FIG. 4) such that the bicycle computer unit 16, 216 is longitudinal offset from the band section 40 along the bicycle handlebar 14, 214.

Claim 15

Ichida's first electrical shift control switch 40, 42, 44, etc. includes a first operating member 42 arranged and configured to move relative to the first mounting portion 41 between a first neutral position and a first actuating position. Ichida, claims 1-25.

Claim 16

Ichida's operating member 42 is further arranged and configured to be selectively moved relative to the mounting portion 41 between the neutral position (FIG. 4) and a second actuating position (FIG. 6) that is spaced from the first actuating position (FIG. 5). Ichida, ¶ 18.

Claim 17

Ichida's electrical shift control switch 40, 42, 44, etc. further includes a biasing element 48 arranged and configured to urge the operating member 42 to the neutral position. Ichida, ¶ 32.

12. Claims 1-10 and 19-21 are allowed.

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Iteya (FIGS. 8 and 9), Emerson (FIG. 4), and Tiong (FIG. 3).

15. Applicant's arguments filed April 17, 2008 have been fully considered but they are not persuasive.

### **Objections to the Drawings and Specification**

Applicant contended: "Adding this plane P that is perpendicular to the rotational axis X and passes through the center axis C to Figure 7 does not constitute an introduction of new matter. Rather, *such a plane was inherently present in original Figure 7, but was merely not yet explicitly identified.*" (Emphasis added). (Amend. p. 12).

The Examiner respectfully submits that the above contention is unsupported by substantial evidence in the record and/or not in accordance with law for the reasons, *inter alia*, set forth below.

First, it is well settled that the proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale. In fact, MPEP § 2125 states:

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.").

In the instant case, the specification does not disclose that the original drawings are to scale and is silent as to dimensions. Therefore, Applicant's arguments that the original FIG. 7

inherently shows the 90° angle defined by the plane P and the axis X is of little value.  
*Hockerson-Halberstadt, Inc. v. Avia Group Int'l, supra.*

Second, Applicant failed to prove that “such a plane was *inherently present* in original Figure 7” (Emphasis added).

As noted, “to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. *The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). See MPEP § 2163.07(a).

Here, even though original FIG. 7 shows that the operating member 61 is disposed on an opposite side of the split of the portion 30, however, there are an infinite number of the planes passing the center axis C. See, e.g., the planes P1, P2, and P3 in the Appendix 2. After the filing date, the specific description, showing, and claiming of a particular plane P perpendicular to the axis X within a full spectrum of possible planes passing the center axis C is considered under the present disclosure to be new matter. *Cf., In re Smith and Ex parte George, supra.*

Third, assuming *arguendo* that “such a plane was inherently present in original Figure 7” as alleged, MPEP § 608.04(a) states:

Matter Not in Original Specification, Claims, or Drawings  
Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, *the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter.* See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960

C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers*, 108 USPQ 444 (Bd. App. 1955) (new use). For rejection of claim involving new matter, see MPEP § 706.03(o).

In the case at hand, the original specification is totally silent about the plane P as Applicant admitted. Hence, the addition of the alleged inherent plane P may be new matter.

Fourth, Applicant specifically amended the claims to claim the plane P on August 2, 2007. If the plane P that is perpendicular to the axis X is the best mode contemplated by Applicant, Applicant should have shown that plane P *on the filing date* pursuant to 37 CFR 1.83(a), not on the date of the amendment. Please see MPEP § 608.01(h) quoted below:

*If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). *Any proposed amendment of this type should be treated as new matter.*

Patents have been held invalid in cases where the patentee did not disclose the best mode known to him or her. See *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990); *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415, 8 USPQ2d 1692 (Fed. Cir. 1988); *Spectra-Physics, Inc. v. Coherent, Inc.*, 821 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987) (Emphasis added).

More importantly, 35 USC 113 states:

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. *Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the*

*purpose of interpretation of the scope of any claim.* (Emphasis added).

See also 37 CFR 1.81(d). In the case at hand, Applicant used the drawings submitted after the filing date for the purpose of interpretation of amended claims 22-31.

In view of the foregoing, the Examiner respectfully declines Applicant's request to withdraw the objections to the drawings and specification.

The Examiner acknowledges that Applicant filed a petition under 37 CFR 1.181 on January 15, 2008 regarding the above objections. If this petition is granted, these objections will be withdrawn.

**35 USC § 112, ¶ 1<sup>st</sup>**

In the same vein of arguments, Applicant contended that even though the plane P was not identified, the plane P was inherently disclosed, thus, the rejection under 35 USC 112, ¶ 1<sup>st</sup> should be withdrawn.

The above reasons for objections to the drawings and specification are incorporated herein by reference. If the petition filed on January 15, 2008 is granted, this ground of rejection will be withdrawn.

**35 USC § 112, ¶ 2n**

The previous rejections under 35 USC 112, second paragraph, are withdrawn in view of Applicant's amendments to the claims.

**35 USC §§ 102 and 103**

The previous rejection under 35 USC 102(b) based on Matsui and 35 USC 103 based on Ichida et al. in view of Matsui are withdrawn in view of Applicant's amendments, particularly, the new limitation "the bicycle computer being . . . *within* the split" in claim 11. However, this

new limitation is unsupported by the original specification and/or inconsistent with Applicant's drawings (FIGS. 3 and 18). Thus, it necessitates new grounds of rejections above. Applicant's arguments with respect to claims 11-18 have been considered but are moot in view of the new ground(s) of rejection.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/  
Primary Examiner, Art Unit 3656